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10/759,185

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Hidenori Suzuki

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EXAMINER

SQUIRES, ELIZA A

ART UNIT

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4156

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/759,185 | Applicant(s) SUZUKI ET AL. | |
| | Examiner Eliza Squires | Art Unit 4156 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/20/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: page 2 line 3 contains the term “left habit” should be amended to read “life habit”. Appropriate correction is required.

Claim Objections

2. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

3. Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim refers to a recording medium containing the output control program of claim 10. This claim fails the infringement test as the recording medium containing the output control program, claim 11, could conceivably be infringed without infringing upon the performance of the program of claim 10.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claim 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

- a. **Claim 1, 2, 6, and 7 are rejected for being vague and indefinite; section (b);**

(b) a first sending means for selecting, [for claim 6 “sending device which selects”], from the second sets of physical information stored for said each of the second patients by the memory device, a plurality of second sets of physical information obtained from at least one second patient after a prescribed past time point, when a second set of physical information obtained from said at least one second patient at the prescribed past time point falls within a first range determined based on a first set of physical information obtained from the first patient at the prescribed past time point, and when a second prescribed target value corresponding to the second set of physical information obtained at the prescribed past time point falls within a second range determined based on a first prescribed target value corresponding to the first set of physical information obtained at the prescribed past time point, and sending the selected second sets of physical information obtained after the prescribed past time point ; and

is comprised of language that does not reasonably and clearly convey applicant’s invention. It is unclear what the limitation “past time point” means or the relationships between the range, target, past time point, and the physical information are; one of ordinary skill in the art would not be reasonably apprised of the scope of the invention, and the claim is therefore rejected.

Claim 2 and 7, which is dependant on claim 1 and 6 respectively, fail to rectify this deficiency and are rejected for the same reasons.

For the purposes of examination, the examiner reads these sections as a [sending] device by which a patient records their physical information within a time frame. The second patient's information is then displayed on the device corresponding to their change in, or current status of, physical information for the same interval as the first patient.

Claim 1 and 6 section (d);

(d) a first output device which outputs, for the first patient, a plurality of first sets of physical information obtained from the first patient after the prescribed past time point and said selected second sets of physical information obtained from said at least one second patient after the prescribed past time point, such that a first time-wise change of the outputted first sets of physical information and a second time-wise change of the outputted second sets of physical information are comparable with each other.

is comprised of language that is so cumbersome that it cannot reasonably understood. For the purposes of examination, examiner interprets this section as an output device that displays the result of step (b).

b. **Claims 2, 4, 7 and 9** are rejected for being vague and indefinite. The claims recite a relationship between sending, receiving, outputting, and a "past time point". It is unclear what the limitation "past time point" means and its relationships. For the purposes of examination, the limitations relating to a "past time point" will be omitted, as the examiner cannot speculate the meaning of this phrase, the omitted passages will appear crossed out in the art rejection.

c. **Claims 3 and 8** recite,

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a sending means for selecting, [for claim 8 “sending device which selects”], from the second sets of physical information stored for said each of the second patients by the memory device, a plurality of second sets of physical information obtained from at least one second patient after a prescribed past time point, when a second set of physical information obtained from said at least one second patient at the prescribed past time point falls within a first range determined based on a first set of physical information obtained from the first patient at the prescribed past time point, and when a second prescribed target value corresponding to the second set of physical information obtained at the prescribed past time point falls within a second range determined based on a first prescribed target value corresponding to the first set of physical information obtained at the prescribed past time point, and sending the selected second sets of physical information obtained after the prescribed past time point, and a plurality of first sets of physical information obtained from the first patient after the prescribed past time point, and stored by the memory device, to an output device which outputs, for the first patient, the second sets of physical information obtained after the prescribed past time point, and the first sets of physical information obtained after the prescribed past time point, such that the outputted first sets of physical information and the outputted second, sets of physical information are comparable, with each other.

is comprised of language that does not reasonably and clearly convey applicant's invention. It is unclear what the limitation “past time point” means or the relationships between the target, past time point, and the physical information are; one of ordinary skill in the art would not be reasonably apprised of the scope of the invention, and the claim is therefore rejected.

Claim 4 and 9, which are dependant on claims 3 and 8 respectively, fail to rectify this deficiency and are rejected for the same reasons.

For the purposes of examination, the examiner reads these sections as a [sending] device by which a patient records their physical information within a time frame. The second patient's information is then displayed on the device corresponding to their change in, or current status of, physical information for the same interval as the first patient.

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d. **Claims 1-4, 6-7** are rejected for being vague and indefinite. Below is a quotation of 112 6th paragraph:

“An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.”

Claims 1, 3, and 4 recite the limitation a “sending means for selecting”, this is unclear as the applicant uses means for language which invokes the use of 112 6th; however, there is no corresponding structure in the specification which clearly discloses what may comprise the means for selecting. For the purposes of this examination this will be interpreted as shown within the art rejections for the various claims.

Claims 6 and 8 recite the limitation a “sending device for selecting” this would be read to mean a device dedicated solely to the transmission of data, it does not seem plausible for a transmission device (i.e. a modem, a network interface card, ect.) to additionally have the capability of also selecting data from a database, this ordinarily would be dedicated to a computer processor which interprets code for this purpose, or the like apparatus; one of ordinary skill in the art would not be reasonably apprised of the scope of this limitation. For the purposes of this examination this will be interpreted as shown within the art rejections for the various claims.

Claim 2 and 7 are rejected as they fail to remedy the deficiency of claim 1 and respectively claim 6 and they are therefore rejected for the same

reasons. For the purposes of this examination this will be interpreted as shown within the art rejections for the various claims.

e. **Claim 5** is rejected for being vague and indefinite; the claim is comprised of language that does not reasonably and clearly convey applicant's invention the limitations "past time point" and its relation to the various limitations of targets and ranges are incomprehensible. For the purposes of examination the sections in this claim pertaining to this language will be omitted, appearing crossed-out in the art rejection.

f. **Claim 11** is rejected for being vague and indefinite; the claim recites a recording medium for recording..., which for "a recording medium" examiner would assume to mean "a computer readable medium". In a product claim, this medium would contain instructions to be read by a processor. However, it appears that this medium is performing the act of recording, making it unclear if this was meant to be a product claim or a method claim. Secondly, it is unclear how the recording medium, for illustration, a compact disk, would possess the ability to record upon itself the computer program thus rendering the claim indefinite. For the purposes of examination, the claim will be interpreted as "A computer readable medium containing the output control program of claim 10."

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claims 5 and 10-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.** A computer program per se, as the claims are directed to is non-statutory subject matter as it is none of a process, machine, article of manufacture, or composition of matter as required by 35 U.S.C. 101 and the claims are therefore rejected. Claim 11 is dependant on claim 10 and fails to rectify its faults and are therefore rejected for the same reasons. For the purposes of examination, they will be examined as method claims. If applicant chooses to amend this claim to be directed to a method, applicant should be aware that in order for a method to be considered a "process" under 35 U.S.C. 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 U.S.C. 101 and is nonstatutory subject matter.

8. **Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.** Data per se, as directed to by the claim, is non statutory. Claims to computer-related inventions that are clearly nonstatutory fall

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into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute “descriptive material.” Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” *The New IEEE Standard Dictionary of Electrical and Electronics Terms* 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se. *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Claim 11 fails a tie between a computer readable medium and an action performed on a computer. The claim is merely directed to a computer data. Proper format should resemble the following:

“A computer readable medium storing a computer program containing instructions thereon for instructing a computer to perform the steps of: ...”

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1-11** are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Application No. JP 2002109064 A to *Chokai* et al.

11. **As to claim 1**, *Chokai* discloses a life habit improvement assisting system, comprising:

a first physical-information obtaining device which iteratively obtains a plurality of first sets of physical information from a first patient (paragraph [0018]);

a plurality of second physical-information obtaining devices each of which iteratively obtains a plurality of second sets of physical information from a corresponding one of a plurality of second patients (paragraphs [0016] and [0018]);

a server apparatus including

(a) a memory device which-stores the first sets of physical information obtained from the first patient by the first physical-information obtaining device, and the second sets of physical information obtained from each of the second patients by a corresponding one of the second physical-information obtaining devices, such that the first sets of physical information are associated with the first patient and the second sets of

physical information is associated with said each of the second patients
(paragraphs [0016], [0018], [0017], [0037], and [0039]) and

[(b) a first sending means for selecting, from the second sets of physical information stored for said each of the second patients by the memory device, a plurality of second sets of physical information obtained from at least one second patient after a prescribed past time point, when a second set of physical information obtained from said at least one second patient at the prescribed past time point falls within a first range determined based on a first set of physical information obtained from the first patient at the prescribed past time point, and when a second prescribed target value corresponding to the second set of physical information obtained at the prescribed past time point falls within a second range determined based on a first prescribed target value corresponding to the first set of physical information obtained at the prescribed past time point, and sending the selected second sets of physical information obtained after the prescribed past time point ; and]

Since the limitations for this section of the claim cannot be understood, the rejection for this section will be based on examiners interpretation.

(b) A [sending] device by which a patient records their physical information within a time frame. The second patient's information is then sent to the first patients device corresponding to their change in, or current status of, physical information for the same interval as the first patient (paragraph [0039]).

a first patient's terminal device including

(c) a first receiving means for receiving, from the sending means of the server apparatus, said selected second sets of physical information obtained after the prescribed past time point (paragraphs [0016], [0018], [0017], [0037], and [0039]), and

Since the limitations for this section of the claim cannot be understood, the rejection for this section will be based on examiners interpretation.

[(d) a first output device which outputs, for the first patient, a plurality of first sets of physical information obtained from the first patient after the prescribed past time point and said selected second sets of physical information obtained from said at least one second patient after the prescribed past time point, such that a first time-wise change of the outputted first sets of physical information and a second time-wise change of the outputted second sets of physical information are comparable with each other.]

(d) an output device that displays the result of step b)

(paragraphs [0021], [0035], and [0039]).

12. **As to claim 2**, see the discussion of claim 1, additionally, *Chokai* further discloses the system further comprising;

at least one second patient's terminal device corresponding to said at least one second patient, wherein the server apparatus further comprises a second sending means for sending the first sets of physical information obtained from the first patient ~~after the prescribed past time point~~, and stored by the memory device, to said at least one second patient's terminal device (paragraphs [0020], [0021], [0031], and [0039]); and

wherein said at least one second patient's terminal device comprises;

(e) a second receiving means for receiving the first sets of physical information ~~obtained after the prescribed past time point~~, and sent from the second sending means (paragraphs [0020], [0021], [0031], and [0039]), and

(f) a second output device which outputs, for said at least one second patient, the first sets of physical information obtained from the first patient

~~after the prescribed past time point~~, and received by the second receiving means, and the second sets of physical information obtained from said at least one second patient ~~after the prescribed past time point~~, and selected by the first sending means, such that the first time-wise change of the outputted first sets of physical information and the second time-wise change of the outputted second sets of physical information are comparable with each other (paragraphs [0020], [0021], [0031], and [0039]).

13. **As to claim 3**, *Chokai* discloses a server apparatus for use in a life habit improvement assisting system, the apparatus comprising:

a memory device which stores a plurality of first sets of physical information iteratively obtained from a first patient by a first physical-information obtaining device and iteratively sent from the first physical-information obtaining device, and a plurality of second sets of physical information iteratively obtained from each of a plurality of second patients by a corresponding one of a plurality of second physical-information obtaining devices and iteratively sent from said one second physical-information obtaining device (paragraphs [0020], [0021], [0031], and [0039]); and

Since the limitations for this section of the claim cannot be understood, the rejection for this section will be based on examiners interpretation.

a sending means for selecting, from the second sets of physical information stored for said each of the second patients by the memory device, a plurality of second sets of physical information obtained from at least one second patient after a prescribed past time point, when a second set of physical information obtained from said at least one

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second patient at the prescribed past time point falls within a first range determined based on a first set of physical information obtained from the first patient at the prescribed past time point, and when a second prescribed target value corresponding to the second set of physical information obtained at the prescribed past time point falls within a second range determined based on a first prescribed target value corresponding to the first set of physical information obtained at the prescribed past time point, and

a [sending] device by which a patient records their physical information within a time frame. The first patient's information is then displayed on the second device corresponding to their change in, or current status of, physical information for the same interval as the first patient (paragraph [0039]).

a sending means that sends the selected second sets of physical information ~~obtained after the prescribed past time point~~, and a plurality of first sets of physical information obtained from the first patient ~~after the prescribed past time point~~, and stored by the memory device, to an output device which outputs, for the first patient, the second sets of physical information ~~obtained after the prescribed past time point~~, and the first sets of physical information ~~obtained after the prescribed past time point~~, such that the outputted first sets of physical information and the outputted second sets of physical information are comparable with each other (paragraphs [0020], [0021], [0031], and [0039]).

14. **As to claim 4**, see the discussion of claim 3, additionally, *Chokai* discloses the apparatus wherein the sending means selects, from the second sets of physical information stored for said each of the second patients by the memory device, a plurality of second sets of physical information obtained from each of a plurality of second patients ~~after the prescribed past time point~~, and sends the selected second sets of

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physical information obtained from said each of the second patients ~~after the prescribed past time point~~ (paragraphs [0020], [0021], [0031], and [0039]).

15. **As to claim 5**, *Chokai* discloses an output control program for use in a life habit improvement assisting system, the program comprising:

a physical-information receiving means for receiving, via a communication line, a plurality of first sets of physical information iteratively obtained from a first patient ~~after a prescribed past time point~~, and a plurality of second sets of physical information iteratively obtained from at least one second patient ~~after the prescribed past time point~~, ~~when a second set of physical information obtained from said at least one second patient at the prescribed past time point falls within a first range determined based on a first set of physical information obtained from the first patient at the prescribed past time point~~, and ~~when a second prescribed target value corresponding to the second set of physical information obtained at the prescribed past time point falls within a second range determined based on a first prescribed target value corresponding to the first set of physical information obtained at the prescribed past time point~~, and an output control means for operating an output device to output the first and second sets of physical information obtained ~~after the prescribed past time point~~, and received by the receiving means, such that a first time-wise change of the outputted first sets of physical information and a second time-wise change of the outputted second sets of physical information are comparable with each other (paragraphs [0016], [0018], [0017], [0037], and [0039] wherein a communication line is a portable telephone).

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15. **As to claim 6**, since the claim is substantially the same as claim 1, the only change between the two is a “sending means” is replaced by “sending device”, which are used interchangeably in the specification (i.e. paragraph [0025]) see the discussion of claim 1.

16. **As to claim 7**, since the claim is substantially the same as claim 2, the only change between the two is a “sending means” is replaced by “sending device” (i.e. paragraph [0025]), see the discussion of claim 2.

17. **As to claim 8**, since the claim is substantially the same as claim 3, the only change between the two is a “sending means” is replaced by “sending device” (i.e. paragraph [0025]), see the discussion of claim 3.

18. **As to claim 9**, since the claim is substantially the same as claim 4, the only change between the two is a “sending means” is replaced by “sending device” (i.e. paragraph [0025]), see the discussion of claim 4.

19. **As to claim 10**, since the claim is substantially the same as claim 5, the only change between the two is that the program of claim 10 comprises steps while 5 comprises “means for” (i.e. paragraph [0023]), see the discussion of claim 4.

20. **As to claim 11**, see the discussion of claim 10, additionally, *Chokai* discloses a recording medium containing the output control program according to claim 10 (paragraphs [0016], [0018], [0017], [0037], and [0039]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eliza Squires whose telephone number is (571)270-7052. The examiner can normally be reached on Monday through Friday 8 am - 4 pm Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on 571-272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eliza Squires/
Examiner, Art Unit 4156
8/29/08

/Charles R. Kyle/
Supervisory Patent Examiner, Art Unit 4156